



## Department of Energy

Washington, DC 20585

June 20, 2006

### MEMORANDUM

SUBJECT: CONSIDERATION OF LATE FILED WAIVER PETITIONS, IPI

Our regulations require that waivers for identified inventions must be submitted not later than eight months after conception and/or first actual reduction to practice, whichever occurs first, or "such longer period as may be authorized by the Patent Counsel... for good cause shown in writing by the requestor." See 10 CFR 784.8(c).

When it is apparent from a review of your files that a waiver petition has not been submitted within the eight month period, the issue of timely filing should be dealt with by requesting a written explanation for the delay before considering the merits of the petition. In cases where procedures will regularly cause petitions by employee inventors to be late filed, the processing of waiver requests should be expedited by advising the employee inventor to submit a letter of explanation concurrently with the petition. Explanations should be reviewed based on whether the goals of the agency would be better served by considering or refusing to consider the waiver petition on its merits, whether any Government rights would be compromised, and whether intervening events have made grant of the waiver inappropriate.

In general, employee inventors are subject to more delays in submitting waiver petitions, and Patent Counsel should be lenient in considering their explanations for late filed petitions. Reasons which have recently been accepted as "good cause" include the following:

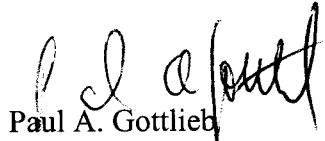
- the employee inventor filed promptly after receiving authorization from the contractor;
- the employee inventor relied on Contractor information that authorization would be denied during his term of employment but filed promptly thereafter.

When a waiver request is for an invention covered by an issued DOE patent, such a waiver has the possibility of conflicting with the statutory scheme of P. L.96-517 for granting rights in federally owned inventions through licensing as well as with the patent program of DOE. The licensing process begins with the publication of a notice of the availability of the invention for licensing. Therefore, to assure the uniform development of policy for handling late filed waiver requests, any such request should be referred to this office for handling where it pertains to an invention on which DOE has filed a patent application that has been advertised for licensing. Advertisement for licensing usually takes place shortly after issuance of a U.S. Patent. In order to find out whether such advertisement has taken place for a particular invention, you may search



DOE's Invention Licensing Website at [www.OSTI.DOE.GOV/DUBLINCORE/GENCNCL/](http://www.OSTI.DOE.GOV/DUBLINCORE/GENCNCL/).

It should be noted that every effort should be made to coordinate waivers with patent application filing, i.e., avoid filing where a waiver is about to be granted or expedite waiver processing before the patent application must be filed.

A handwritten signature in black ink, appearing to read "Paul A. Gottlieb", is positioned above the printed name.

Paul A. Gottlieb  
Assistant General Counsel  
for Technology Transfer and Intellectual Property